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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,184	02/06/2004	Nobuyuki Kakuda	OPW-002	7208

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LAHIVE & COCKFIELD, LLP.
28 STATE STREET
BOSTON, MA 02109

EXAMINER

NASH, BRIAN D

ART UNIT PAPER NUMBER

3721

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,184

Applicant(s)

KAKUDA ET AL.

Examiner

Brian Nash

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 14, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/6/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings in this application are objected to because they are informal. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3-4, 8-10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 in its entirety is vague, indefinite, and confusing because it is not clear what limitations are encompassed by the claim. Specifically, it is not clear if the magazine is configured to store a plurality of fasteners at different times or configured to store a plurality of fasteners varying in length all at the same time. The examiner has construed the claims to define the former. Additionally, the second half of the claim would benefit from some punctuation in

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order to clearly ascertain what structural limitations the applicant is trying to define. Further, it is indefinite to structurally define a location of the detection recess dependent upon the length of a fastener since the fastener length is not quantified and the tool's magazine is configured to store a plurality of fasteners varying in length.

In claim 13, the terminology "formed in continuity with the engaging surface" is vague, indefinite, and confusing because it is not clear what structural limitations are encompassed by the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 6-7, 11-12, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,180,091 to Ota. Ota shows the same invention including a fastener driving tool having a driver guide (6) coupled to the tool defining a fastener driving channel (5), a magazine (8), a pusher plate (18), a driver (2), a trigger (23), a stopper member (27) forming an idle driving prevention device (21, 27, 28, 29) the stopper member coupled to the trigger and arranged to prevent a driving operation when no fastener exists (see column 5, lines 7-14), a detection recess (lower 22) defined on an inner wall of the fastener driving channel in a position not opposing the head of a fastener that has been fed into the driving channel, a restriction plate (lower 20 – see Fig. 9) disposed in the magazine and biased in a fastener feeding direction, the end portion of the

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restriction plate enters the detection recess permitting movement of the restriction plate whereby the stopper member is engaged for inhibiting the operation of the trigger when no fastener is positioned within the driving channel.

Regarding claim 7, Ota does not explicitly disclose that the detection member (lower protrusion 20) moves a distance greater than the thickness of the fastener when the last fastener has been driven out from the driving channel. However, after the last fastener is expelled from the driving channel, the detection member (lower protrusion 20) moves a distance equal to the sum of the width of the driving channel and the width of the detection recess (22). It is therefore inherent that the detection member will always move a distance greater than the thickness of the fastener.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,180,091 to Ota. As discussed above in this action, Ota discloses the invention substantially as claimed including a stopper member (27) having both a horizontal recess (28) and a vertical recess (29) that provide engaging surfaces for the engaging portion (21) of the plate (18) so that the plate is shifted in a direction away from the fastener driving channel as the two surfaces make contact in the feed direction of fasteners. While Ota does not explicitly show the stopper

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member to have an inclined surface formed thereon and adjacent to the engaging recess, it would have been obvious to one skilled in the art to configure/modify the stopper member of Ota in order to have an inclined surface rather than adjacent horizontal and vertical grooves since such a modification is within the engineering purview of the skilled artisan concerned with providing the a means for engagement between the stopper member and the plate such that the plate is shifted in a direction away from the fastener driving channel.

9. Claims 2-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,180,091 to Ota in view of US 5,927,585 to Moorman et al. As discussed above in this action, Ota discloses the invention substantially as claimed, but does not show a fastener driving tool having a magazine configured to store a plurality of fasteners of varying length. Fastener driving tools having this type of magazine are well known in the art. Moorman et al show a fastener driving tool having a magazine that stores and sequentially urges fasteners toward a driving channel and teaches a magazine that accommodates plural fasteners of varying lengths (see Moorman et al, claim 8). It would have been obvious to one having ordinary skill in the art to combine the magazine of Moorman et al with the tool of Ota for the purpose of having a fastener driving tool that accommodates a plurality of fasteners having varying lengths.

Allowable Subject Matter

10. Claims 14 and 17-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Obergfell et al, Muller et al, Massari, Mukoyama et al, Yang, and Smolinski et al are cited to show related references.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467.

The official fax number for this Group is: 703-872-9306

Brian Nash
9 February 2005

A handwritten signature in black ink, appearing to read 'Scott A. Smith', with a stylized, sweeping flourish extending to the right.

SCOTTA SMITH
PRIMARY EXAMINER